APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/772,244	01/29/2001	Rajkishore Barik	JP920000376US1	9198

7590 06/13/2007	EXAMINER
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	ART UNIT	PAPER NUMBER
	3622	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	09/772,244	BARIK ET AL.
	Examiner	Art Unit
	Jeffrey D. Carlson	3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>28 July 2006 and 05 September 2006</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-5,7-12,14-19,21-31,33-44,46-57,59-62 and 64-66</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-5,7-12,14-19,21-31,33-44,46-57,59-62 and 64-66</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>17 October 2006</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

This action is responsive to the paper(s) filed 7/28/06 and 9/5/06.

Claim Objections

1.   Claims 19, 61, 65 are objected to because of the following informalities:

- ■   Claim 19, "means for" should be inserted before each instance of "checking".

- ■   Claim 61, "computer program product means for" should be inserted before each instance of "computing".

- ■   Claim 65 does not further limit the structure of the system/apparatus, but rather states where such system/apparatus is located. The location of an article does not serve to define the structure of the article.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

2.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3.   Claims 14, 21, 72, 73 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- ■   Claim 14 is an apparatus claim, yet appears to describe how the apparatus is used rather than structural features of the apparatus. The body of claim 8 has structure (by way of the means for elements), but there is no structure

claimed in 8 or 14 which provides any structural connection to any type of network.

■   Claim 21 is an apparatus/program on a medium claim, yet appears to describe how the apparatus is used rather than programmed features of the apparatus/medium. The body of claim 15 has structure (by way of the code means for elements), but there is no structure claimed in 21 or 15 which provides any network connections or programmed capabilities.

■   Claim 72, it is unclear what structure is being further limited by the claim. The claim appears to be more of a method claim which is confusing.

■   Claim 73, it is unclear what structure/programming is being further limited by the claim. The claim appears to be more of a method claim which is confusing.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5.   **Claims 1-5, 7-12, 14-19, 21-31, 33, 35-44, 46, 48-57, 59, 61-62, 65, 66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fajkowski (US6932270).**

Regarding claims 1, 2, 3, 8-10, 15-17, 27, 30, 41, 44, 54, 57, Fajkowski teaches

systems and methods for storing electronic coupons, associating them with customers,

presenting them at a retail POS and redeeming them. A user is provided with a card

which provides a userID [4:6-8]. The card is used to associate selected coupons from a

plurality of available coupons from different sources (by scanning paper coupons, by

selecting coupons at a kiosk or by downloading coupons from the Internet) with the

user's account in a database [3:63-65, 6:1-5, 6:22-25]. When the card is presented at

the POS along with products to be purchased, the POS system determines what

coupons of the user's collection of selected coupons are redeemable given the user's

potential purchases; the system displays these coupons on the display [16:18-31,

17:31-33, 4:25-35]. Fajkowski teaches that the coupon eligibility parameters (product

name, required size, quantity or combination of items required, expiration) may be

stored on the card in order to determine applicable coupons at the POS [10:17-26].

Applicant admits that mutual exclusivity is a restrictive, eligibility coupon parameter

often used [spec page 1 lines 21-22]. It would have been obvious for one of ordinary

skill in the art at the time of the invention to have stored and analyzed other well known

coupon restriction rules such as whether other coupons can be used in combination

with a coupon. Doing so would enable the system to process and accurately display a

wide variety of eligible coupons, including those with exclusivity rules. Examiner will

now address the limitations associated with checking if eligible coupons also meet

optimization parameters. Applicant has admitted that customers frequently have a

collection of eligible coupons from which to choose, leaving the consumer with the task

of determining which subset of eligible coupons to use. It has been done manually, but it is admittedly difficult in certain situations [spec pg 2 lines 11-19]. Historically checkout clerks inherently were required to possess the ability to determine coupon eligibility, else fraudulent coupon redemption would be possible. One of ordinary skill would consider it to be a matter of good customer service for a checkout clerk to assist a customer regarding which coupons could be used (i.e. eligibility) as well which subset of coupons would most benefit the customer for example helping a customer who asks "which coupon(s) would save the most money?". There should be no doubt that consumers frequently use coupons in order to get the best savings. It would have been obvious to one of ordinary skill at the time of the invention to have provided assistance to customers faced with navigating the coupon rules and options imposed by the retailer. Fajkowski's system accomplishes the automated eligibility determination in the manner of an Expert System (a computer system programmed to replace a human clerk having the knowledge to determine eligibility for the universe of participating coupons and their restrictions/parameters). Fajkowski's system is also quite intelligent in that it can recommend an additional purchase when a consumer possesses a valuable coupon, but has not fully met the purchasing qualifications (perhaps the user chose the wrong size product) [19:38-43]. This is another example of an Expert System capability. Fajkowski's system has been argued to lack presentation to the consumer of a subset of all eligible coupons according to price optimization, yet it would have been obvious to one of ordinary skill at the time of the invention to have provided this desired but heretofore manual capability in an automated manner. See Automating a manual

activity - MPEP 2144.04(III). *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958).

Regarding claims 4, 11, 18, Fajkowski teaches that coupons could be displayed which are not fully eligible along with the reasoning for their near-eligible status, such as the product is the wrong size [19:38-43]. It would have been obvious for one of ordinary skill in the art at the time of the invention to have displayed a similar message when a user has not presented the proper quantity or combination of products [these parameters are disclosed at 10:22-23] when possessing a coupon with such size or quantity restrictions. Both of these examples are taken to provide a teaching of recommending the missing product to the customer for more discounts.

Regarding claims 5, 12, 19, 35, 48, 61, 65, 66, Fajkowski teaches that the coupons may at least be stored at a third party site (Internet) or kiosk (retailer site). The system is taken to reside at the retailer site.

Regarding claims 7, 14, 21, the network is described as the Internet.

Regarding claims 22, 23, 36, 37, 49, 50, 62, Fajkowski's determination of coupons specific to products presented is taken to provide a step of computing a set of coupons dependant upon a user's set of coupons as well as upon the order information. The step of determining if the computed coupon set complies with redeeming conditions is met by inspecting the other various criteria such as expiration, etc.

Regarding claim 24, 38, 51, if in Fajkowski a customer provides a coupon that does not comply with redemption criteria, the customer is free to return another time with a another set of coupons.

Regarding claims 25, 26, 39, 40, 52, 53, Fajkowski teaches that while compliant coupons are shown at the POS, the customer may wish to investigate why some coupons were non-complaint [19:21-25]. The POS may be used to display all coupons that were non-compliant [19:44-53]; it would have been obvious for one of ordinary skill in the art at the time of the invention to have displayed non-compliant coupons for any non-compliant criteria including the suggested mutually exclusive criteria above.

Regarding claims 28, 29, 42, 43, 55, 56, Fajkowski teaches that the user may save shopping lists with specified coupons for the products on the list to be used on future shopping trips. Fajkowski also teaches the idea of issuing a rain check for a coupon item the user wishes to purchase, but where the item is currently unavailable. The system will save such a list of rain-checked product(s) for later use. In either case, future use of the saved lists are taken to meet the broad "comparing" by a user.

Regarding claim 31, Fajkowski teaches that a user may be provided with reports of coupon usage and savings [13:5-7, 17:48-63]. User acceptance for redemption of the displayed eligible coupons provides a viewing of reports of coupon usage.

Regarding claim 33, 46, 59, the system is taken to inherently use an AND condition for a coupon having plural redemption conditions (expiration date and product size, for example).

Claims 3, 10, 17 (alternatively) and 34, 47, 60, 64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fajkowski in view of Beach et al (US2002/0107738).

Beach et al also teaches user collection of e-coupons which are redeemed at the POS [para. 13]. Beach et al teaches that coupons can be recommended to the user based on his user profile [para. 35 (middle of page)]. It would have been obvious for one of ordinary skill in the art at the time of the invention to have suggested coupons for the user based on his profile so that the user can be conveniently targeted with offers that are likely to be accepted and purchased. These recommendations are taken to be optimal or near optimal recommendations.

Claims 1-5, 7-12, 14-19, 21-31, 33, 35-44, 46, 48-57, 59, 61-62, 65, 66 are alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over Fajkowski (US6932270) in view of Marmon (US4446528).

Regarding claims 1, 2, 3, 8-10, 15-17, 27, 30, 41, 44, 54, 57, Fajkowski teaches systems and methods for storing electronic coupons, associating them with customers, presenting them at a retail POS and redeeming them. A user is provided with a card which provides a userID [4:6-8]. The card is used to associate selected coupons from a plurality of available coupons from different sources (by scanning paper coupons, by selecting coupons at a kiosk or by downloading coupons from the Internet) with the user's account in a database [3:63-65, 6:1-5, 6:22-25]. When the card is presented at the POS along with products to be purchased, the POS system determines what coupons of the user's collection of selected coupons are redeemable given the user's potential purchases; the system displays these coupons on the display [16:18-31, 17:31-33, 4:25-35]. Fajkowski teaches that the coupon eligibility parameters (product

name, required size, quantity or combination of items required, expiration) may be

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optimization parameters. Applicant has admitted that customers frequently have a

collection of eligible coupons from which to choose, leaving the consumer with the task

of determining which subset of eligible coupons to use. It has been done manually, but

it is admittedly difficult in certain situations [spec pg 2 lines 11-19]. Historically checkout

clerks inherently were required to possess the ability to determine coupon eligibility,

else fraudulent coupon redemption would be possible. Marmon teaches that shopping

can get quite complicated when pricing systems are combined with cents off coupons

and retailers offer to double or triple coupons [col 1 lines 38-42]. Fajkowski provides a

calculating tool for optimizing purchasing decisions affected by the complex pricing

combinations that include coupons [col 1 lines 50-60]. Marmon notes that the consumer

is confronted with many price-affecting choices related to coupons and that he usually is

seeking low prices [col 2 lines 53-57]. Understanding the choice of optimum purchase

requires and understanding of coupon procedures (i.e. rules) and unit pricing

techniques [col 3 lines 20-22]. The calculations done by the system of Fajkowski consider the impact of the coupon and the optimum choice, i.e. lowest until price is indicated to the user [col 3 lines 51-53]. Fajkowski's system accomplishes the automated eligibility determination and it would have been obvious to one of ordinary skill at the time of the invention to have also provided automated coupon optimization assistance (i.e. indicating the best coupon(s) to use in order to best reduce the price given the subset of eligible coupons possessed) to customers faced with navigating the coupon rules and options imposed by the retailer. This would enable the customer to most benefit from his coupons, delivery the lowest prices as is generally desired as well as encourage purchasing of retailer products.

Regarding claims 4, 11, 18, Fajkowski teaches that coupons could be displayed which are not fully eligible along with the reasoning for their near-eligible status, such as the product is the wrong size [19:38-43]. It would have been obvious for one of ordinary skill in the art at the time of the invention to have displayed a similar message when a user has not presented the proper quantity or combination of products [these parameters are disclosed at 10:22-23] when possessing a coupon with such size or quantity restrictions. Both of these examples are taken to provide a teaching of recommending the missing product to the customer for more discounts.

Regarding claims 5, 12, 19, 35, 48, 61, 65, 66, Fajkowski teaches that the coupons may at least be stored at a third party site (Internet) or kiosk (retailer site). The system is taken to reside at the retailer site.

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Response to Arguments

Applicant re: claim 65 argues that defining where the system is located further defines the system. Examiner disagrees. What structure of the apparatus is further

being defined? A widget is a widget whether it is inside or outside or in a drawer or on the floor.

Applicant argues that the art does not teach a user defining optimization parameters. The new rejection above addresses the concept that the user desires to optimize according to price, for example.

Applicant argues that the art fail to teach mutual exclusivity. However applicant admits these are well known usage restrictions/parameters. Given this admitted evidence. the examiner believes one of ordinary skill would find it obvious to respect these parameters when presenting eligible coupons.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- ■ Aggarwal et al (7013286) teaches electronic coupon redemption and a system that determines eligible coupons as well as helps the customer decide what coupon(s) to use if the customer reveals what coupons he has [col 12 lines 44-50].

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 571-272-6716. The examiner can normally be reached on Mon-Fri 8a-5:30p, (work from home on Thursdays).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Eric Stamber can be reached on (571)272-6724. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

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USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jeffrey D. Carlson
Primary Examiner
Art Unit 3622

jdc